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10/718,505

11/20/2003

Ronald D. McCallister

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08/06/2010

Fogg & Powers LLC/Intersil Americas Inc.
5810 W. 78th Street
Minneapolis, MN 55439

EXAMINER

CORRIELUS, JEAN B

ART UNIT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD D. MCCALLISTER, BRUCE A. COCHRAN, and
BRADLEY P. BADKE

Appeal 2009-014375
Application 10/718,505
Technology Center 2600

Before JOHN A. JEFFERY, ROBERT E. NAPPI, and MARC S. HOFF,
Administrative Patent Judges.

NAPPI, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

BACKGROUND

Appellants have filed a paper under 37 CFR § 41.52 requesting that we reconsider our decision of March 18, 2010 where we affirmed the rejections of claims 2 through 11 and 13 through 23. We reconsider our decision in light of Appellants' Request for Rehearing, but we decline to change the decision.

Appellants contend that:

1. Mr. McAllister's testimony regarding the May reference can not be given weight as he is prevented from providing such testimony under the Doctrine of Assignor Estoppel.
2. Mr. Birch's Testimony has been misapprehended by the Board. Mr. Birch did not testify that a delay is taught by May.
3. The Evidence of record provides the showing required by *In re Wands* that the disclosure of May does not enable a delay.

Initially, we note that 37 C.F.R. 41.52 (a)(1) states:

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section.

ISSUES

Appellants' arguments directed to issues 1 and 3 were not presented in the Briefs. Specifically, Appellants' arguments on pages 11 through 13 of the Brief, which discuss Mr. McCallister's testimony, do not assert that it is barred based upon estoppel. Similarly, Appellants' arguments, on pages 10

and 11 of the Appeal Brief, directed to May not providing an enabling disclosure do not address the *Wands* factors. Thus, the issues raised by Appellants' arguments directed to issues 1 and 3 were not presented in the Briefs and as such they were waived and they have not been considered.

Issue 2.

Appellants argue on page 3 of the Request for Rehearing:

While Birch does say what kind of delay May would require, Birch does not testify that delay is taught in May. The statements about delay in May (paragraphs 11 and 12) are based on Mr. Birch's understanding of the present invention and Mr. Birch's knowledge as an expert. It is not based on what is taught in May and it is not based on what one of ordinary skill in the art would understand as inherent in May.

This line of reasoning has not convinced us of error in our Finding of Fact 3 of our March 18, 2010 decision. Statements 11 and 12 of Mr. Birch's May 17, 2006 declaration both state "[t]he delay in May . . . would be a variable delay." Further, statements 3-14 in the May 17, 2006 declaration are all directed to the May reference and make no mention of the Appellants' invention. As such, we do not find that the evidence supports Appellants' assertion that statements 11 and 12 are based on Mr. Birch's understanding of the present invention. Therefore, ample evidence supports our finding that Mr. Birch testified that there is a delay in May.

CONCLUSION

For the aforementioned reasons, Appellants' three contentions have not persuaded us of error in our March 18, 2010 decision.

Accordingly, while we have granted Appellants' Request for Rehearing to the extent that we have reconsidered our decision, that request is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REHEARING DENIED

tkl

FOGG & POWERS LLC
5810 W 78TH STREET
SUITE 100
MINNEAPOLIS, MN 55439